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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/619,028	07/19/2000	Louis H. Sciupac	DTC 00-03	2216
3897	7590	10/04/2004	EXAMINER	
SCHNECK & SCHNECK P.O. BOX 2-E SAN JOSE, CA 95109-0005			TREMBLAY, MARK STEPHEN	
			ART UNIT	PAPER NUMBER
			2876	

DATE MAILED: 10/04/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/619,028

**Applicant(s)**

SCIUPAC ET AL.

**Examiner**

Mark Tremblay

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6/25/02 11/4/02</u>   | 6) <input type="checkbox"/> Other: ____                                     |

***Claim Rejections - 35 USC § 112***

Claim 3 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Re claim 3, claim 1 indicates that the storage medium has information on it, and claim 3 recites that the storage medium is blank. Which is it?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-6, 15-19, 21-23, and 29-33 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent #6,101,477 to Hohle et al. ("Hohle" hereinafter). Hohle discloses, in a system of reading data encoded on a storage medium 100, a method of business interaction between a broker 10 and an agency 12 comprising:  
providing a user with a secure storage medium smartcard 100;  
recording personal transaction information (e.g. EF 504, 510-512, 518, 526) and biometric data EF 522, 714, etc. on the medium;  
verifying the user identification with the biometric data using cardholder ID application 406;  
reading selected portions of the information (see column 5, lines 30-63, and elsewhere);  
transmitting selected information to said broker 10 (see column 5, line 64 to column 6, line 17 and column 26, line 36 through column 27, line 67) and the broker using said selected information to broker a transaction between said agency 12 and said user

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through the use of access rules described in Hohle which control access to information seen by the agency 12.

Re claim 3, if "blank" means "having some user data", Hohle teaches this.

Re claim 2, see column 28, line 14.

Re claim 23, a retinal scan is a picture of a portion of said user.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-14, 20, 24-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Hohle.

Re claim 7, Official notice is taken that known card issuers, acting as brokers between agencies and users, charge fees. A good example is VISA, which charges a percentage fee per transaction, as is notoriously well known in the art.

Re claim 8, providing equipment as a means to generate fees, as claimed in claim 7, is obvious because the ongoing fees can be made high enough to pay for the equipment, as is old and well known in the art.

Re claims 9-12, 20, 24-27 these claims recite methods which were old and well known in association with card transactions at the time the invention was made, and would have been obvious additions to the teachings of Hohle because they were common card methods.

Re claim 28, the claim is so broad as to read on any number of volatile processes in which the data is "destroyed" or overwritten after it is used. Surely, within the network, after the data is used, it is destroyed. In many of the buffers the data encounters between the card and databases 11 and 13, the data is destroyed by being overwritten.


Re claims 13-14, the Internet and web pages were notoriously old and well known for providing data to agencies, card issuers, and customers at the time the invention was made. Hohle teaches one administrative database on broker 10's system. However, the database clearly will contain information about the broker 10, agencies 12, and users. The collections of data for each of these entities within the database can be considered separate databases in their own right, as well as a larger combined database. It would have been obvious to a person having ordinary skill in the art at the time the invention was made to provide web pages for access to the data for the users, broker, and agencies, because each of these entities has information stored in the database, and Internet web pages were a common, default method for accessing information among physically separated entities such as brokers (like VISA), agencies (like airlines) and users (like customers of airlines with reservations).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

U. S. Patent #5878141 and 5884271 are cited for showing other brokered multi-function smart card systems.

**Voice**

Inquiries for the Examiner should be directed to Mark Tremblay at (571) 272-2408. The Examiner's regular office hours are 10:30 am to 7:00 pm EST Monday to Friday. Voice mail is available. If Applicant has trouble contacting the Examiner, the Supervisory Patent Examiner, Michael Lee, can be reached on (571) 272-2398. Technical questions and comments concerning PTO procedures may be directed to the Patent Assistance Center hotline at 1-800-786-9199 or (703) 308-4357.

  
**MARK TREMBLAY**  
**PRIMARY EXAMINER**  
September 30, 2004